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10/767,766	01/30/2004	Hidchiko Ogawa	P24498	5536

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EXAMINER	
CHENG, PETER L	

ART UNIT	PAPER NUMBER
2625	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/767,766	OGAWA, HIDEHIKO	
	Examiner	Art Unit	
	PETER L. CHENG	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 January 2004* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date *Continuation Sheet*.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to because:

- **Fig. 3:** for step **S10**, it is assumed that applicant intended to cite **Use Default as Transmitter's ID** instead of **Use Defaults as Transmitter's ID**;

- **Fig. 3:** for step **S8**, it is assumed that applicant intended to cite **Set Transmitter's ID** instead of ***Settle* Transmitter's ID**;

- **Fig. 5B:** in the line starting with **From: "suzuki"** a left bracket "<" before the e-mail address **fax@aaa.bbb.jp** is missing;

- **Fig. 9A:** since the table in **Fig. 2B** is labeled, **Transmitter's Identification Table**, for clarity, suggest renaming the table shown in **Fig. 9A**; for example, **Transmitter's ID Verification Table**;

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an

amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The abstract of the disclosure is objected to because:

- **Line 3:** since a "**mail from command**" appears to be referring to the SMTP "Mail From:" command, for clarity, suggest changing **The e-mail including a mail from command and a mail message** to **The e-mail includes an SMTP "mail from" command and a mail message**;

Correction is required. See MPEP § 608.01(b).

3. The disclosure is objected to because of the following informalities:

- The applicant may choose to implement the following suggestions; for example, **page 1, paragraph 3, lines 6 - 7 (**replace "into a facsimile machine" with "to a facsimile machine"**); page 2, paragraph 4, line 14 (**replace "delivered to a wrong address" with "delivered to the wrong person"**); page 3, paragraph 10, line 7 (**replace "answer data" with "reply"**); page 4, paragraph 11, line 6** *from the top of page 4* **(**replace "an transmitter's" with "a transmitter's"**); page 6, line 1 (**there appears to be an extra space between the letters "w" and "h" in the word "where"**); page 6, line 1 (**there appears to be an extra space between the letters "I" and "D" in the word "ID"**); page 6, line 1 (**there appears to be an extra space between the letters "a" and "r" in the word "are"**); page 8, paragraph 19, line 1 (**suggest replacing "Names of CPUs" with "Names of host computers"**); page 8, paragraph 19, line 7 (**replace "to send" with "and send"**); page 12, paragraph 33, line 1 (**replace "the default" with either "the default mail address" or "the default e-mail address"**); page 13, paragraph 40, line 2 (**replace "The command" with "The mail from command"**); page 14, paragraph 45, line 3 (**replace "does not have a transmitter" with "does not have a transmitter's name"**); page 14, paragraph 46, lines 5 and following (**for clarity, suggest re-writing the sentence beginning with "The E-mail address cannot be *shown to the E-mail transfer message protocol ...*"**); page 19, paragraph 61, lines 1 – 3** *from the top of the page* **(**suggest re-writing the sentence beginning with "When

changing the E-mail address of transmitter ..."**);**

- **Page 4, paragraph 12, line 8:** regarding the description for **Fig. 2B**, for consistency with the descriptions of **Figs. 6 – 8** and other parts of the specification, suggest replacing **a table of transmitter's identification** with **a transmitter's identification (ID) table**;

- **Page 5, paragraph 12, 4th line from the bottom of the page:** as with the suggestion for **Fig. 9A** above, suggest replacing **shows an exemplary transmitter's ID table** with **shows an exemplary transmitter's ID *verification* table**;

- **Page 5, paragraph 12, 4th line from the bottom of the page:** suggest replacing **where identifications have been registered** with **where IP addresses have been registered**;

- **Page 11, paragraph 30, line 6:** with respect to **Fig. 3**, step **S6**, for clarity, it is assumed that applicant intended to cite **change the name using the transmitter's ID table** instead of **change the name in the transmitter's ID table**;

- **Page 13, paragraph 38, line 2:** with respect to **Fig. 4**, step **S15**, for clarity, it

is assumed that applicant intended to cite **change these two factors using the transmitter's ID table in S15** instead of **change these two factors in the table in S15**;

- **Page 15, paragraph 49, line 7:** in conformance with the suggestion made in paragraph 12, suggest replacing **transmitter's ID table** with **transmitter's ID verification table**;

- **Page 16, paragraph 52, line 3:** similarly, suggest replacing **transmitter's ID table** with **transmitter's ID verification table**;

- **Page 16, paragraph 53, line 4:** similarly, suggest replacing **transmitter's ID table** with **transmitter's ID verification table**;

- **Page 16, paragraph 53, line 7:** similarly, suggest replacing **transmitter's ID table** with **transmitter's ID verification table**;

Appropriate correction is required.

Claim Objections

4. Claim 3 is objected to because of the following informalities:

- **Line 2:** since the **image data communication apparatus** comprises a **panel section** [claim 1], and the **panel section** comprises a **personal computer** [claim 3], this would suggest that the **personal computer** is part of the **image data communication apparatus**; however, claim 3 cites that the **personal computer** is "connected" to the **image data communication apparatus** which suggests that it is separate from the **image data communication apparatus**;

5. Claim 8 is objected to because of the following informalities:

- **Line 2:** since the **image data communication apparatus** comprises a **panel section** [claim 6], and the **panel section** comprises a **personal computer** [claim 8], this would suggest that the **personal computer** is part of the **image data communication apparatus**; however, claim 8 cites that the **personal computer** is "connected" to the **image data communication apparatus** which suggests that it is separate from the **image data communication apparatus**;

6. Claim 11 is objected to because of the following informalities:

- **Line 10:** it is assumed that applicant intended to cite **whereby, when an error occurs** instead of **whereby, the an error occurs**;

7. Claim 13 is objected to because of the following informalities:

- **Line 2:** since the **image data communication apparatus** comprises a **panel section** [claim 11], and the **panel section** comprises a **personal computer** [claim 13], this would suggest that the **personal computer** is part of the **image data communication apparatus**; however, claim 13 cites that the **personal computer** is "connected" to the **image data communication apparatus** which suggests that it is separate from the **image data communication apparatus**;

8. Claim 22 is objected to because of the following informalities:

- **Lines 4 - 5:** the phrase **a memory storing a mail address of at least one user** appears "misplaced"; it is assumed that **memory** is part of the **image data communication apparatus**;

9. Claim 24 is objected to because of the following informalities:

- **Lines 4 - 5:** the phrase **a memory storing a mail address of at least one user** appears "misplaced"; it is assumed that **memory** is part of the **image data communication apparatus**;

10. Claim 26 is objected to because of the following informalities:

- **Lines 4 - 5:** the phrase **a memory storing a mail address of at least one user** appears "misplaced"; it is assumed that **memory** is part of the **image data communication apparatus**;

11. Claim 28 is objected to because of the following informalities:

- **Lines 4 - 5:** the phrase **a memory storing a mail address of at least one user** appears "misplaced"; it is assumed that **memory** is part of the **image data communication apparatus**;

- **Lines 7 - 8:** similar to claims 1, 16 and 22, it is assumed that applicant did not intend to cite ***whereby a mail error message is returned to the mail address of the user***, that is, it is assumed that this limitation should be removed;

12. Claim 30 is objected to because of the following informalities:

- **Lines 4 - 5:** the phrase **a memory storing a mail address of at least one user** appears "misplaced"; it is assumed that **memory** is part of the **image data communication apparatus**;

- **Lines 8 - 9:** similar to claims 6, 18 and 24, it is assumed that applicant did not intend to cite ***whereby a mail error message is returned to the mail***

address of the user; that is, it is assumed that this limitation should be removed;

13. Claim 32 is objected to because of the following informalities:

- **Lines 4 - 5:** the phrase **a memory storing a mail address of at least one user** appears "misplaced"; it is assumed that **memory** is part of the **image data communication apparatus**;

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims **1 - 5** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1 - 5** of **U.S. Patent No. 7,139,092**. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time the invention was made to both (1) utilize a "server" for both forward (e.g., transmitting image data attached to an e-mail) and return (e.g., an error message) communications and (2) "input a mail address of a user" from a "panel section" and later retrieve the address from a "memory" by "selecting" it from the same "panel section".

This sequence is taught by **TOYODA [Japanese Patent JP4 10307769, published November 17, 1998]**.

Per the English translation provided by applicant, TOYODA teaches a procedure for registering a "mail address of a sender into the facsimile type e-mail apparatus" and cites, "It is possible to input the mail address of the destination and the mail address of the sender directly by utilizing a keyboard"; **page 13** (*of the English translation*), **paragraph 27, lines 1 – 4.** Later, when an e-mail is transmitted, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*).

The following table compares the corresponding independent claims. With the exception of "panel section" [of the instant application] and "panel" [of patent 7,139,092], the wording of the corresponding dependent claims appears to be the same.

INSTANT APPLICATION	US PATENT 7139092

1. An image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message, the image data communication apparatus comprising:	1. An image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail to a receiving apparatus through a server via the network, the e-mail including a mail from command and a mail message, the image data communication apparatus comprising:
a memory configured to store a mail address of at least one user;	
a panel section configured to select the mail address of at least one user stored in the memory;	a panel configured to input a mail address of a user to the image data communication apparatus;
and a controller configured to set the mail address of the user selected by the panel section into the mail from command of the e-mail to which the image data is attached,	and a controller configured to set the mail address of the user, input by the panel, into the mail from command of the e-mail to which the image data is attached, the mail from command being utilized for communication between the image data communication apparatus and the server,
whereby, when an error occurs, the mail address of the user set into the mail from command of the e-mail is utilized as a destination of a mail error message.	whereby, when an error occurs, the mail address of the user set into the mail from command of the e-mail is utilized as a destination of a mail error message, the mail error message being returned from the server.

15. Claims **6 - 10** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **6 - 10** of **U.S. Patent No. 7,139,092**. Although the conflicting claims are not identical, they are not patentably

distinct from each other because it would have been obvious to one of ordinary skill in the art at the time the invention was made to both (1) utilize a "server" for both forward (e.g., transmitting image data attached to an e-mail) and return (e.g., an error message) communications and (2) "input a mail address of a user" from a "panel section" and later retrieve the address from a "memory" by "selecting" it from the same "panel section". This sequence is taught by **TOYODA [Japanese Patent JP4 10307769A, published November 17, 1998]**.

Per the English translation provided by applicant, TOYODA teaches a procedure for registering a "mail address of a sender into the facsimile type e-mail apparatus" and cites, "It is possible to input the mail address of the destination and the mail address of the sender directly by utilizing a keyboard"; **page 13** (*of the English translation*), **paragraph 27, lines 1 – 4.** Later, when an e-mail is transmitted, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*).

The following table compares the corresponding independent claims. With the exception of "panel section" [of the instant application] and "panel" [of patent 7,139,092], the wording of the corresponding dependent claims appears to be the same.

INSTANT APPLICATION	US PATENT 7139092
6. An image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message, the image data communication apparatus comprising:	6. An image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail to a receiving apparatus through a server via the network, the e-mail including a mail from command and a mail message, the image data communication apparatus comprising:
a memory configured to store a mail address of at least one user;	
a panel section configured to select the mail address of at least one user stored in the memory;	a panel configured to input a mail address of a user to the image data communication apparatus;
a controller configured to set the mail address of the user selected by the panel section into the mail from command of the e-mail to which the image data is attached,	and a controller configured to set the mail address of the user, input by the panel, into the mail from command of the e-mail to which the image data is attached, the mail from command being utilized for communication between the image data communication apparatus and the server,
whereby, when an error occurs, a mail error message is returned to the mail address of the user.	whereby, when an error occurs, a mail error message is returned from the server to the mail address of the user.

16. Claims **11 - 15** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **11 - 15** of **U.S. Patent No. 7,139,092**. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in

the art at the time the invention was made to both (1) utilize a "server" for both forward (e.g., transmitting image data attached to an e-mail) and return (e.g., an error message) communications and (2) "input a mail address of a user" from a "panel section" and later retrieve the address from a "memory" by "selecting" it from the same "panel section". This sequence is taught by **TOYODA [Japanese Patent JP4 10307769A, published November 17, 1998]**.

Per the English translation provided by applicant, TOYODA teaches a procedure for registering a "mail address of a sender into the facsimile type e-mail apparatus" and cites, "It is possible to input the mail address of the destination and the mail address of the sender directly by utilizing a keyboard"; **page 13** (*of the English translation*), **paragraph 27, lines 1 – 4.** Later, when an e-mail is transmitted, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*).

The following table compares the corresponding independent claims. With the exception of "panel section" [of the instant application] and "panel" [of patent 7,139,092], the wording of the corresponding dependent claims appears to be the same.

INSTANT APPLICATION	US PATENT 7139092

11. An image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message, the image data communication apparatus comprising:	11. An image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail to a receiving apparatus through a server via the network, the e-mail including a mail from command and a mail message, the image data communication apparatus comprising:
a memory configured to store a mail address of at least one user;	
a panel section configured to select the mail address of at least one user stored in the memory;	a panel configured to input a mail address of a user to the image data communication apparatus;
a controller configured to set the mail address of the user selected by the panel section into the mail from command of the e-mail to which the image data is attached,	and a controller configured to set the mail address of the user, input by the panel, into the mail from command of the e-mail to which the image data is attached, the mail from command being utilized for communication between the image data communication apparatus and the server,
whereby, the an error occurs, a mail error message is returned to the mail address of the user, the mail error message indicating an error in one of transmission of the e-mail by the image data communication apparatus and reception of the e-mail by the receiving apparatus.	whereby, when an error occurs, a mail error message is returned from the server to the mail address of the user, the mail error message indicating an error in one of transmission of the e-mail by the image data communication apparatus and reception of the e-mail by the receiving apparatus.

17. Claims **16 – 17** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **16 – 17** of **U.S. Patent No.**

7,139,092. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time the invention was made to both (1) utilize a "server" for both forward (e.g., transmitting image data attached to an e-mail) and return (e.g., an error message) communications and (2) "input a mail address of a user" from a "panel section" and later retrieve the address from a "memory" by "selecting" it from the same "panel section". This sequence is taught by **TOYODA [Japanese Patent JP4 10307769A, published November 17, 1998]**.

Per the English translation provided by applicant, TOYODA teaches a procedure for registering a "mail address of a sender into the facsimile type e-mail apparatus" and cites, "It is possible to input the mail address of the destination and the mail address of the sender directly by utilizing a keyboard"; **page 13** (*of the English translation*), **paragraph 27, lines 1 – 4.** Later, when an e-mail is transmitted, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*).

The following table compares the corresponding independent claims. The wording of the corresponding dependent claims appears to be the same.

INSTANT APPLICATION	US PATENT 7139092
16. An image data communication apparatus connected to a network, the image data communication apparatus comprising:	16. An image data communication apparatus connected to a network, the image data communication apparatus comprising:
a transmitter configured to transmit image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message;	a transmitter configured to transmit image data attached to an e-mail to a receiving apparatus through a server via the network, the e-mail including a mail from command and a mail message;
a memory configured to store a mail address of at least one user;	
a panel section configured to select the mail address of at least one user stored in the memory;	a panel configured to input a mail address of a user to the image data communication apparatus;
a controller configured to set the mail address of the user selected by the panel section into the mail from command of the e-mail to which the image data is attached,	and a controller configured to set the mail address of the user, input by the panel, into the mail from command of the e-mail to which the image data is attached, the mail from command being utilized for communication between the image data communication apparatus and the server,
whereby, when an error occurs, the mail address of the user set into the mail from command of the e-mail is utilized as a destination of a mail error message.	whereby, when an error occurs, the mail address of the user set into the mail from command of the e-mail is utilized as a destination of a mail error message, the mail error message being returned from the server.

18. Claims **18 - 19** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **18 - 19** of **U.S. Patent No.**

7,139,092. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time the invention was made to both (1) utilize a "server" for both forward (e.g., transmitting image data attached to an e-mail) and return (e.g., an error message) communications and (2) "input a mail address of a user" from a "panel section" and later retrieve the address from a "memory" by "selecting" it from the same "panel section". This sequence is taught by **TOYODA [Japanese Patent JP4 10307769A, published November 17, 1998]**.

Per the English translation provided by applicant, TOYODA teaches a procedure for registering a "mail address of a sender into the facsimile type e-mail apparatus" and cites, "It is possible to input the mail address of the destination and the mail address of the sender directly by utilizing a keyboard"; **page 13** (*of the English translation*), **paragraph 27, lines 1 – 4.** Later, when an e-mail is transmitted, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*).

The following table compares the corresponding independent claims. The wording of the corresponding dependent claims appears to be the same.

INSTANT APPLICATION	US PATENT 7139092
18. An image data communication apparatus connected to a network, the image data communication apparatus comprising:	18. An image data communication apparatus connected to a network, the image data communication apparatus comprising:
a transmitter configured to transmit image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message;	a transmitter configured to transmit image data attached to an e-mail to a receiving apparatus through a server via the network, the e-mail including a mail from command and a mail message;
a memory configured to store a mail address of at least one user;	
a panel section configured to select the mail address of at least one user stored in the memory;	a panel configured to input a mail address of a user to the image data communication apparatus;
a controller configured to set the mail address of the user selected by the panel section into the mail from command of the e-mail to which the image data is attached,	and a controller configured to set the mail address of the user, input by the panel, into the mail from command of the e-mail to which the image data is attached, the mail from command being utilized for communication between the image data communication apparatus and the server,
whereby, when an error occurs, a mail error message is returned to the mail address of the user.	whereby, when an error occurs, a mail error message is returned from the server to the mail address of the user.

19. Claims **20 - 21** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **20 - 21** of **U.S. Patent No. 7,139,092**. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in

the art at the time the invention was made to both (1) utilize a "server" for both forward (e.g., transmitting image data attached to an e-mail) and return (e.g., an error message) communications and (2) "input a mail address of a user" from a "panel section" and later retrieve the address from a "memory" by "selecting" it from the same "panel section". This sequence is taught by **TOYODA [Japanese Patent JP4 10307769A, published November 17, 1998]**.

Per the English translation provided by applicant, TOYODA teaches a procedure for registering a "mail address of a sender into the facsimile type e-mail apparatus" and cites, "It is possible to input the mail address of the destination and the mail address of the sender directly by utilizing a keyboard"; **page 13** (*of the English translation*), **paragraph 27, lines 1 – 4.** Later, when an e-mail is transmitted, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*).

The following table compares the corresponding independent claims. The wording of the corresponding dependent claims appears to be the same.

INSTANT APPLICATION	US PATENT 7139092

20. An image data communication apparatus connected to a network, the image data communication apparatus comprising:	20. An image data communication apparatus connected to a network, the image data communication apparatus comprising:
a transmitter configured to transmit image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message;	a transmitter configured to transmit image data attached to an e-mail to a receiving apparatus through a server via the network, the e-mail including a mail from command and a mail message;
a memory configured to store a mail address of at least one user;	
a panel section configured to select the mail address of at least one user stored in the memory;	a panel configured to input a mail address of a user to the image data communication apparatus;
a controller configured to set the mail address of the user selected by the panel section into the mail from command of the e-mail to which the image data is attached,	and a controller configured to set the mail address of the user, input by the panel, into the mail from command of the e-mail to which the image data is attached, the mail from command being utilized for communication between the image data communication apparatus and the server,
whereby, the an error occurs, a mail error message is returned to the mail address of the user, the mail error message indicating an error in one of transmission of the e-mail by the image data communication apparatus and reception of the e-mail by the receiving apparatus.	whereby, when an error occurs, a mail error message is returned from the server to the mail address of the user, the mail error message indicating an error in one of transmission of the e-mail by the image data communication apparatus and reception of the e-mail by the receiving apparatus.

20. Claims **22 - 23** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **22 - 23** of **U.S. Patent No.**

7,139,092. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time the invention was made to both (1) utilize a "server" for both forward (e.g., transmitting image data attached to an e-mail) and return (e.g., an error message) communications and (2) "input a mail address of a user" from a "panel section" and later retrieve the address from a "memory" by "selecting" it from the same "panel section". This sequence is taught by **TOYODA [Japanese Patent JP4 10307769A, published November 17, 1998]**.

Per the English translation provided by applicant, TOYODA teaches a procedure for registering a "mail address of a sender into the facsimile type e-mail apparatus" and cites, "It is possible to input the mail address of the destination and the mail address of the sender directly by utilizing a keyboard"; **page 13** (*of the English translation*), **paragraph 27, lines 1 – 4.** Later, when an e-mail is transmitted, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*).

The following table compares the corresponding independent claims. The wording of the corresponding dependent claims appears to be the same.

INSTANT APPLICATION	US PATENT 7139092
22. A method for controlling an image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message, a memory storing a mail address of at least one user, the method comprising:	22. A method for controlling an image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail to a receiving apparatus through a server via the network, the e-mail including a mail from command and a mail message, the method comprising:
selecting the mail address of at least one user stored in the memory;	inputting a mail address of a user to the image data communication apparatus;
setting the selected mail address of the user into the mail from command of the e-mail to which the image data is attached,	and setting the input mail address of the user into the mail from command of the e-mail to which the image data is attached, the mail from command being utilized for communication between the image data communication apparatus and the server,
whereby, when an error occurs, the mail address of the user set into the mail from command of the e-mail is utilized as a destination of a mail error message.	whereby, when an error occurs, the mail address of the user set into the mail from command of the e-mail is utilized as a destination of a mail error message, the mail error message being returned from the server.

21. Claims **24 - 25** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **24 - 25** of **U.S. Patent No. 7,139,092**. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time the invention was made to both (1) utilize a "server" for both forward

(e.g., transmitting image data attached to an e-mail) and return (e.g., an error message) communications and (2) "input a mail address of a user" from a "panel section" and later retrieve the address from a "memory" by "selecting" it from the same "panel section". This sequence is taught by **TOYODA [Japanese Patent JP4 10307769A, published November 17, 1998]**.

Per the English translation provided by applicant, TOYODA teaches a procedure for registering a "mail address of a sender into the facsimile type e-mail apparatus" and cites, "It is possible to input the mail address of the destination and the mail address of the sender directly by utilizing a keyboard"; **page 13** (*of the English translation*), **paragraph 27, lines 1 – 4.** Later, when an e-mail is transmitted, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*).

The following table compares the corresponding independent claims. The wording of the corresponding dependent claims appears to be the same.

INSTANT APPLICATION	US PATENT 7139092

24. A method for controlling an image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message, a memory storing a mail address of at least one user, the method comprising:	24. A method for controlling an image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail to a receiving apparatus through a server via the network, the e-mail including a mail from command and a mail message, the method comprising:
selecting the mail address of at least one user stored in the memory;	inputting a mail address of a user to the image data communication apparatus;
setting the selected mail address of the user into the mail from command of the e-mail to which the image data is attached,	and setting the input mail address of the user into the mail from command of the e-mail to which the image data is attached, the mail from command being utilized for communication between the image data communication apparatus and the server,
whereby, when an error occurs, a mail error message is returned to the mail address of the user.	whereby, when an error occurs, a mail error message is returned from the server to the mail address of the user.

22. Claims **26 - 27** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **26 - 27** of **U.S. Patent No. 7,139,092**. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time the invention was made to both (1) utilize a "server" for both forward (e.g., transmitting image data attached to an e-mail) and return (e.g., an error message) communications and (2) "input a mail address of a user" from a "panel section" and later

retrieve the address from a "memory" by "selecting" it from the same "panel section". This sequence is taught by **TOYODA [Japanese Patent JP4 10307769A, published November 17, 1998]**.

Per the English translation provided by applicant, TOYODA teaches a procedure for registering a "mail address of a sender into the facsimile type e-mail apparatus" and cites, "It is possible to input the mail address of the destination and the mail address of the sender directly by utilizing a keyboard"; **page 13** (*of the English translation*), **paragraph 27, lines 1 – 4.** Later, when an e-mail is transmitted, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*).

The following table compares the corresponding independent claims. The wording of the corresponding dependent claims appears to be the same.

INSTANT APPLICATION	US PATENT 7139092

26. A method for controlling an image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message, a memory storing a mail address of at least one user, the method comprising:	26. A method for controlling an image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail to a receiving apparatus through a server via the network, the e-mail including a mail from command and a mail message, the method comprising:
selecting the mail address of at least one user stored in the memory;	inputting a mail address of a user to the image data communication apparatus;
setting the selected mail address of the user into the mail from command of the e-mail to which the image data is attached,	and setting the input mail address of the user into the mail from command of the e-mail to which the image data is attached, the mail from command being utilized for communication between the image data communication apparatus and the server,
whereby, the an error occurs, a mail error message is returned to the mail address of the user, the mail error message indicating an error in one of transmission of the e-mail by the image data communication apparatus and reception of the e-mail by the receiving apparatus.	whereby, when an error occurs, a mail error message is returned from the server to the mail address of the user, the mail error message indicating an error in one of transmission of the e-mail by the image data communication apparatus and reception of the e-mail by the receiving apparatus.

23. Claims **28 - 29** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **28 - 29** of **U.S. Patent No. 7,139,092**. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in

the art at the time the invention was made to both (1) utilize a "server" for both forward (e.g., transmitting image data attached to an e-mail) and return (e.g., an error message) communications and (2) "input a mail address of a user" from a "panel section" and later retrieve the address from a "memory" by "selecting" it from the same "panel section". This sequence is taught by **TOYODA [Japanese Patent JP4 10307769A, published November 17, 1998]**.

Per the English translation provided by applicant, TOYODA teaches a procedure for registering a "mail address of a sender into the facsimile type e-mail apparatus" and cites, "It is possible to input the mail address of the destination and the mail address of the sender directly by utilizing a keyboard"; **page 13** (*of the English translation*), **paragraph 27, lines 1 – 4.** Later, when an e-mail is transmitted, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*).

The following table compares the corresponding independent claims. The wording of the corresponding dependent claims appears to be the same.

INSTANT APPLICATION	US PATENT 7139092

28. A method for controlling an image data communication apparatus connected to a network, and transmitting image data attached to an e-mail, the e-mail including a mail from command and a mail message, a memory storing a mail address of at least one user, the method comprising:	28. A method for controlling an image data communication apparatus connected to a network, and transmitting image data attached to an e-mail through a server via the network, the e-mail including a mail from command and a mail message, the method comprising:
selecting the mail address of at least one user stored in the memory;	inputting a mail address of a user to the image data communication apparatus;
setting the selected mail address of the user into the mail from command of the e-mail to which the image data is attached,	setting the input mail address of the user into the mail from command of the e-mail to which the image data is attached, the mail from command being utilized for communication between the image data communication apparatus and the server,
~~whereby a mail error message is returned to the mail address of the user,~~ whereby, when an error occurs, the mail address of the user set into the mail from command of the e-mail is utilized as a destination of a mail error message;	whereby a mail error message is returned to the mail address of the user, whereby, when an error occurs, the mail address of the user set into the mail from command of the e-mail is utilized as a destination of a mail error message, the mail error message being returned from the server;
and transmitting the image data attached to the e-mail to a receiving apparatus via the network.	and transmitting the image data attached to the e-mail to a receiving apparatus via through the server the network.

24. Claims **30 - 31** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **30 - 31** of **U.S. Patent No. 7,139,092**. Although the conflicting claims are not identical, they are not patentably

distinct from each other because it would have been obvious to one of ordinary skill in the art at the time the invention was made to both (1) utilize a "server" for both forward (e.g., transmitting image data attached to an e-mail) and return (e.g., an error message) communications and (2) "input a mail address of a user" from a "panel section" and later retrieve the address from a "memory" by "selecting" it from the same "panel section". This sequence is taught by **TOYODA [Japanese Patent JP4 10307769A, published November 17, 1998]**.

Per the English translation provided by applicant, TOYODA teaches a procedure for registering a "mail address of a sender into the facsimile type e-mail apparatus" and cites, "It is possible to input the mail address of the destination and the mail address of the sender directly by utilizing a keyboard"; **page 13** (*of the English translation*), **paragraph 27, lines 1 – 4.** Later, when an e-mail is transmitted, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*).

The following table compares the corresponding independent claims. The wording of the corresponding dependent claims appears to be the same.

INSTANT APPLICATION	US PATENT 7139092

30. A method for controlling an image data communication apparatus connected to a network, and transmitting image data attached to an e-mail, the email including a mail from command and a mail message, a memory storing a mail address of at least one user, the method comprising:	30. A method for controlling an image data communication apparatus connected to a network, and transmitting image data attached to an e-mail through a server via the network, the e-mail including a mail from command and a mail message, the method comprising:
selecting the mail address of at least one user stored in the memory;	inputting a mail address of a user to the image data communication apparatus;
setting the selected mail address of the user into the mail from command of the e-mail to which the image data is attached,	setting the input mail address of the user into the mail from command of the e-mail to which the image data is attached, the mail from command being utilized for communication between the image data communication apparatus and the server,
whereby, when an error occurs, a mail error message is returned to the mail address of the user, ~~whereby a mail error message is returned to the mail address of the user~~;	whereby, when an error occurs, a mail error message is returned from the server to the mail address of the user;
and transmitting the image data attached to the e-mail to a receiving apparatus via the network.	and transmitting the image data attached to the e-mail to a receiving apparatus through the server via the network.

25. Claims **32 - 33** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **32 - 33** of **U.S. Patent No. 7,139,092**. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in

the art at the time the invention was made to both (1) utilize a "server" for both forward (e.g., transmitting image data attached to an e-mail) and return (e.g., an error message) communications and (2) "input a mail address of a user" *from a "personal computer connected to the image data communication apparatus"*, by means of a network connection, and later retrieve the address from a "memory" by "selecting" it from a "panel section". This sequence is taught by **TOYODA [Japanese Patent JP4 10307769A, published November 17, 1998]**.

Per the English translation provided by applicant, TOYODA teaches a procedure for registering a "mail address of a sender into the facsimile type e-mail apparatus" and cites, "It is also possible to input the mail address of the destination and the mail address of the sender" from a PC (i.e., a personal computer) or WS (i.e., a workstation); **page 13** (*of the English translation*), **paragraph 27, lines 1 – 4**; see also **page 4** (*of the English translation*), **paragraph 3, line 3.** Later, when an e-mail is transmitted, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*).

The following table compares the corresponding independent claims. The wording of the corresponding dependent claims appears to be the same.

INSTANT APPLICATION	US PATENT 7139092
32. A method for controlling an image data communication apparatus connected to a network, and transmitting image data attached to an e-mail, the email including a mail from command and a mail message, a memory storing a mail address of at least one, user, the method comprising:	32. A method for controlling an image data communication apparatus connected to a network, and transmitting image data attached to an e-mail through a server via a network, the e-mail including a mail from command and a mail message, the method comprising:
selecting the mail address of at least one user stored in the memory;	inputting, *from a personal computer connected to the image data communication apparatus*, a mail address of a user to the image data communication apparatus;
setting the selected mail address of the user into the mail from command of the e-mail to which the image data is attached,	setting the input mail address of the user into the mail from command of the e-mail to which the image data is attached, the mail from command being utilized for communication between the image data communication apparatus and the server,
whereby, when an error occurs, a mail error message is returned to the mail address of the user, the mail error message indicating an error in one of transmission of the e-mail by the image data communication apparatus and reception of the e-mail by the receiving apparatus;	whereby, when an error occurs, a mail error message is returned from the server to the mail address of the user;
and transmitting the image data attached to the e-mail to a receiving apparatus via the network.	and transmitting the image data attached to the e-mail to a receiving apparatus through the server via the network.

Claim Rejections - 35 USC § 102

26. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

27. Claims 1 - 3, 5 - 8, 10 - 13, and 15 - 33 are rejected under 35 U.S.C. 102(a) as being anticipated by **TOYODA [Japanese Patent JP4 10307769A, published November 17, 1998]**.

As for claim 1, TOYODA teaches an image data communication apparatus

> **[**The description of **Fig. 1** cites a "facsimile type e-mail apparatus which is applied to the present invention"; **page 18** (*of the English translation*)**, paragraph "Fig. 1", lines 1 – 2]**

connected to an image data source

> **[**Per claim 8, the "facsimile type e-mail apparatus" comprises a "scanner"; **page 3** (*of the English translation*)**, lines 1 – 2]**

and to a network

[TOYODA teaches that the "facsimile type e-mail apparatus" is "connected with the network via the LAN"; **page 12** (*of the English translation*), **paragraph 24, lines 1 – 3**],

and transmitting image data attached to an e-mail to a receiving apparatus via the network

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network. A transmitting terminal apparatus describes, in an e-mail, a control command including a predetermined unique character code, and transmits the e-mail. The *receiving apparatus* extracts the control command from the received e-mail at a receiving apparatus, analyzes the control command, and executes a predetermined control, based on the control command"; **page 7** (*of the English translation*), **lines 1 – 7**],

the e-mail including a mail from command and a mail message

[TOYODA teaches that when image data is transmitted by e-mail, "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12.** The sender's address "set in the e-mail" corresponds to the "mail from" command],

the image data communication apparatus comprising:

a memory configured to store a mail address of at least one user

[TOYODA teaches an alternate method of registering mail addresses by the reception of an e-mail and cites, "At the step S46", a "mail address, to which an error mail returns", is "registered in the external memory 4"; **page 15** (*of the English translation*), **paragraph 30, lines 9 – 11];**

a panel section configured to select the mail address of at least one user stored in the memory

[As noted in the double patenting rejection, when an e-mail is transmitted later, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*)**];**

and a controller

[Fig. 1, CPU **1** "is a CPU which controls the facsimile type e-mail apparatus"; **page 11** (*of the English translation*), **paragraph 20, line 5** (*from the top of the page*)**]**

configured to set the mail address of the user selected by the panel section into the mail from command of the e-mail to which the image data is attached, *whereby, when an error occurs,* the mail address of the user set into the mail from command of the e-mail is utilized as a destination of a mail error message

[TOYODA teaches that "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12].**

Regarding claim 2, TOYODA further teaches the image data communication apparatus according to claim 1, wherein

the image data source comprises a scanner connected to the image data communication apparatus

[Per claim 8, the "facsimile type e-mail apparatus" comprises a "scanner"; **page 3** (*of the English translation*), **lines 1 – 2].**

Regarding claim 3, TOYODA further teaches the image data communication apparatus according to claim 1, wherein

the panel section comprises a personal computer connected to the image data communication apparatus

[As noted for the double patenting rejection of claims 32 and 33, TOYODA teaches that a personal computer connected to the "facsimile type e-mail

apparatus" by means of a network connection may serve as the "panel section" for inputting source (i.e., sender) and destination (i.e., recipient) e-mail addresses.

Per the English translation provided by applicant, TOYODA teaches a procedure for registering a "mail address of a sender into the facsimile type e-mail apparatus" and cites, "It is also possible to input the mail address of the destination and the mail address of the sender" from a PC (i.e., a personal computer) or WS (i.e., a workstation); **page 13** (*of the English translation*), **paragraph 27, lines 1 – 4**; see also **page 4** (*of the English translation*), **paragraph 3, line 3]**.

Regarding claim 5, TOYODA further teaches the image data communication apparatus according to claim 1, wherein

the image data attached to the e-mail is converted into a format for e-mail transmission

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network; **page 7** (*of the English translation*), **lines 1 – 2]**.

As for claim 6, TOYODA teaches an image data communication apparatus

[The description of **Fig. 1** cites a "facsimile type e-mail apparatus which is applied to the present invention"; **page 18** (*of the English translation*)**, paragraph "Fig. 1", lines 1 – 2]**

connected to an image data source

[Per claim 8, the "facsimile type e-mail apparatus" comprises a "scanner"; **page 3** (*of the English translation*)**, lines 1 – 2]**

and to a network

[TOYODA teaches that the "facsimile type e-mail apparatus" is "connected with the network via the LAN"; **page 12** (*of the English translation*)**, paragraph 24, lines 1 – 3]**,

and transmitting image data attached to an e-mail to a receiving apparatus via the network

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network. A transmitting terminal apparatus describes, in an e-mail, a control command including a predetermined unique character code, and transmits the e-mail. The *receiving apparatus* extracts the control command from the received e-mail at a receiving apparatus, analyzes the control command, and executes a predetermined

control, based on the control command"; **page 7** (*of the English translation*), **lines 1 – 7]**,

the e-mail including a mail from command and a mail message

[TOYODA teaches that when image data is transmitted by e-mail, "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12.** The sender's address "set in the e-mail" corresponds to the "mail from" command**]**,

the image data communication apparatus comprising:

a memory configured to store a mail address of at least one user

[TOYODA teaches an alternate method of registering mail addresses by the reception of an e-mail and cites, "At the step S46", a "mail address, to which an error mail returns", is "registered in the external memory 4"; **page 15** (*of the English translation*), **paragraph 30, lines 9 – 11];**

a panel section configured to select the mail address of at least one user stored in the memory

[As noted in the double patenting rejection, when an e-mail is transmitted later, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user

designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*)**];**

a controller

[Fig. 1, CPU **1** "is a CPU which controls the facsimile type e-mail apparatus"; **page 11** (*of the English translation*), **paragraph 20, line 5** (*from the top of the page*)**]**

configured to set the mail address of the user selected by the panel section into the mail from command of the e-mail to which the image data is attached, *whereby, when an error occurs,* a mail error message is returned to the mail address of the user

[TOYODA teaches that "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12].**

Regarding claim 7, TOYODA further teaches the image data communication apparatus according to claim 6, wherein

the image data source comprises a scanner connected to the image data communication apparatus

[Per claim 8, the "facsimile type e-mail apparatus" comprises a "scanner"; **page 3** (*of the English translation*), **lines 1 – 2].**

Regarding claim 8, TOYODA further teaches the image data communication apparatus according to claim 6, wherein

the panel section comprises a personal computer connected to the image data communication apparatus

[As noted for the double patenting rejection of claims 32 and 33, TOYODA teaches that a personal computer connected to the "facsimile type e-mail apparatus" by means of a network connection may serve as the "panel section" for inputting source (i.e., sender) and destination (i.e., recipient) e-mail addresses.

Per the English translation provided by applicant, TOYODA teaches a procedure for registering a "mail address of a sender into the facsimile type e-mail apparatus" and cites, "It is also possible to input the mail address of the destination and the mail address of the sender" from a PC (i.e., a personal computer) or WS (i.e., a workstation); **page 13** (*of the English translation*)**, paragraph 27, lines 1 – 4**; see also **page 4** (*of the English translation*)**, paragraph 3, line 3].**

Regarding claim 10, TOYODA further teaches the image data communication apparatus according to claim 6, wherein

the image data attached to the e-mail is converted into a format for e-mail

transmission

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network; **page 7** (*of the English translation*)**, lines 1 – 2].**

As for claim 11, TOYODA teaches an image data communication apparatus

[The description of **Fig. 1** cites a "facsimile type e-mail apparatus which is applied to the present invention"; **page 18** (*of the English translation*)**, paragraph "Fig. 1", lines 1 – 2]**

connected to an image data source

[Per claim 8, the "facsimile type e-mail apparatus" comprises a "scanner"; **page 3** (*of the English translation*)**, lines 1 – 2]**

and to a network

[TOYODA teaches that the "facsimile type e-mail apparatus" is "connected with the network via the LAN"; **page 12** (*of the English translation*)**, paragraph 24, lines 1 – 3]**,

and transmitting image data attached to an e-mail to a receiving apparatus via the network

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network. A transmitting terminal apparatus describes, in an e-mail, a control command including a predetermined unique character code, and transmits the e-mail. The *receiving apparatus* extracts the control command from the received e-mail at a receiving apparatus, analyzes the control command, and executes a predetermined control, based on the control command"; **page 7** (*of the English translation*), **lines 1 – 7**],

the e-mail including a mail from command and a mail message

[TOYODA teaches that when image data is transmitted by e-mail, "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12.** The sender's address "set in the e-mail" corresponds to the "mail from" command],

the image data communication apparatus comprising:

a memory configured to store a mail address of at least one user

[TOYODA teaches an alternate method of registering mail addresses by the reception of an e-mail and cites, "At the step S46", a "mail address, to which an

error mail returns", is "registered in the external memory 4"; **page 15** (*of the English translation*), **paragraph 30, lines 9 – 11];**

a panel section configured to select the mail address of at least one user stored in the memory

[As noted in the double patenting rejection, when an e-mail is transmitted later, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*)**];**

a controller

[Fig. 1, CPU **1** "is a CPU which controls the facsimile type e-mail apparatus"; **page 11** (*of the English translation*), **paragraph 20, line 5** (*from the top of the page*)**]**

configured to set the mail address of the user selected by the panel section into the mail from command of the e-mail to which the image data is attached, *whereby,* ~~the~~ *when an error occurs*, a mail error message is returned to the mail address of the user

[TOYODA teaches that "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12],**

the mail error message indicating an error in *one of* transmission of the e-mail by the image data communication apparatus and reception of the e-mail by the receiving apparatus

[Furthermore, TOYODA teaches that when transmitting image data by e-mail and an "error occurs to the e-mail", a "user can receive an error mail" at "a user's place" instead of at "the transmitting apparatus"; **page 10** (*of the English translation*), **paragraph 19, lines 7 - 9].**

Regarding claim 12, TOYODA further teaches the image data communication apparatus according to claim 11,

wherein the image data source comprises a scanner connected to the image data communication apparatus

[Per claim 8, the "facsimile type e-mail apparatus" comprises a "scanner"; **page 3** (*of the English translation*), **lines 1 – 2].**

Regarding claim 13, TOYODA further teaches the image data communication apparatus according to claim 11,

wherein the panel section comprises a personal computer connected to the image data communication apparatus

[As noted for the double patenting rejection of claims 32 and 33, TOYODA teaches that a personal computer connected to the "facsimile type e-mail apparatus" by means of a network connection may serve as the "panel section" for inputting source (i.e., sender) and destination (i.e., recipient) e-mail addresses.

Per the English translation provided by applicant, TOYODA teaches a procedure for registering a "mail address of a sender into the facsimile type e-mail apparatus" and cites, "It is also possible to input the mail address of the destination and the mail address of the sender" from a PC (i.e., a personal computer) or WS (i.e., a workstation); **page 13** (*of the English translation*), **paragraph 27, lines 1 – 4**; see also **page 4** (*of the English translation*), **paragraph 3, line 3]**.

Regarding claim 15, TOYODA further teaches the image data communication apparatus according to claim 11,

wherein the image data attached to the e-mail is converted into a format for e-mail transmission

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-*

mail transmission, and to transmit the e-mail on a network; **page 7** (*of the English translation*), **lines 1 – 2].**

As for claim 16, TOYODA teaches an image data communication apparatus

[The description of **Fig. 1** cites a "facsimile type e-mail apparatus which is applied to the present invention"; **page 18** (*of the English translation*), **paragraph "Fig. 1", lines 1 – 2]**

connected to a network

[TOYODA teaches that the "facsimile type e-mail apparatus" is "connected with the network via the LAN"; **page 12** (*of the English translation*), **paragraph 24, lines 1 – 3]**,

the image data communication apparatus comprising:

a transmitter configured to transmit image data attached to an e-mail to a receiving apparatus via the network

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network. A transmitting terminal apparatus describes, in an e-mail, a control command including a predetermined unique character code, and transmits the e-mail. The *receiving apparatus* extracts the control command from the received e-mail at a receiving

apparatus, analyzes the control command, and executes a predetermined control, based on the control command"; **page 7** (*of the English translation*), **lines 1 – 7],**

the e-mail including a mail from command and a mail message

[TOYODA teaches that when image data is transmitted by e-mail, "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12.** The sender's address "set in the e-mail" corresponds to the "mail from" command**];**

a memory configured to store a mail address of at least one user

[TOYODA teaches an alternate method of registering mail addresses by the reception of an e-mail and cites, "At the step S46", a "mail address, to which an error mail returns", is "registered in the external memory 4"; **page 15** (*of the English translation*), **paragraph 30, lines 9 – 11];**

a panel section configured to select the mail address of at least one user stored in the memory

[As noted in the double patenting rejection, when an e-mail is transmitted later, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user

designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*)**];**

a controller

[Fig. 1, CPU **1** "is a CPU which controls the facsimile type e-mail apparatus"; **page 11** (*of the English translation*), **paragraph 20, line 5** (*from the top of the page*)**]**

configured to set the mail address of the user selected by the panel section into the mail from command of the e-mail to which the image data is attached, *whereby, when an error occurs*, the mail address of the user set into the mail from command of the e-mail is utilized as a destination of a mail error message

[TOYODA teaches that "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12].**

Regarding claim 17, TOYODA further teaches the image data communication apparatus according to claim 16,

wherein the image data attached to the e-mail is converted into a format for e-mail transmission

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network; **page 7** (*of the English translation*), **lines 1 – 2].**

As for claim 18, TOYODA teaches an image data communication apparatus

[The description of **Fig. 1** cites a "facsimile type e-mail apparatus which is applied to the present invention"; **page 18** (*of the English translation*), **paragraph "Fig. 1", lines 1 – 2]**

connected to a network

[TOYODA teaches that the "facsimile type e-mail apparatus" is "connected with the network via the LAN"; **page 12** (*of the English translation*), **paragraph 24, lines 1 – 3]**,

the image data communication apparatus comprising:

a transmitter configured to transmit image data attached to an e-mail to a receiving apparatus via the network

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network. A transmitting terminal apparatus describes, in an e-mail, a control command including a

predetermined unique character code, and transmits the e-mail. The *receiving apparatus* extracts the control command from the received e-mail at a receiving apparatus, analyzes the control command, and executes a predetermined control, based on the control command"; **page 7** (*of the English translation*), **lines 1 – 7],**

the e-mail including a mail from command and a mail message

[TOYODA teaches that when image data is transmitted by e-mail, "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12.** The sender's address "set in the e-mail" corresponds to the "mail from" command**];**

a memory configured to store a mail address of at least one user

[TOYODA teaches an alternate method of registering mail addresses by the reception of an e-mail and cites, "At the step S46", a "mail address, to which an error mail returns", is "registered in the external memory 4"; **page 15** (*of the English translation*), **paragraph 30, lines 9 – 11];**

a panel section configured to select the mail address of at least one user stored in the memory

[As noted in the double patenting rejection, when an e-mail is transmitted later, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*)];

a controller

[**Fig. 1,** CPU **1** "is a CPU which controls the facsimile type e-mail apparatus"; **page 11** (*of the English translation*), **paragraph 20, line 5** (*from the top of the page*)]

configured to set the mail address of the user selected by the panel section into the mail from command of the e-mail to which the image data is attached, *whereby, when an error occurs*, a mail error message is returned to the mail address of the user

[TOYODA teaches that "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12].**

Regarding claim 19, TOYODA further teaches the image data communication apparatus according to claim 18, wherein

the image data attached to the e-mail is converted into a format for e-mail transmission

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network; **page 7** (*of the English translation*), **lines 1 – 2].**

As for claim 20, TOYODA teaches an image data communication apparatus

[The description of **Fig. 1** cites a "facsimile type e-mail apparatus which is applied to the present invention"; **page 18** (*of the English translation*), **paragraph "Fig. 1", lines 1 – 2]**

connected to a network

[TOYODA teaches that the "facsimile type e-mail apparatus" is "connected with the network via the LAN"; **page 12** (*of the English translation*), **paragraph 24, lines 1 – 3]**,

the image data communication apparatus comprising:

a transmitter configured to transmit image data attached to an e-mail to a receiving apparatus via the network

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-*

mail transmission, and to transmit the e-mail on a network. A transmitting terminal apparatus describes, in an e-mail, a control command including a predetermined unique character code, and transmits the e-mail. The *receiving apparatus* extracts the control command from the received e-mail at a receiving apparatus, analyzes the control command, and executes a predetermined control, based on the control command"; **page 7** (*of the English translation*), **lines 1 – 7],**

the e-mail including a mail from command and a mail message [TOYODA teaches that when image data is transmitted by e-mail, "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12.** The sender's address "set in the e-mail" corresponds to the "mail from" command**];**

a memory configured to store a mail address of at least one user [TOYODA teaches an alternate method of registering mail addresses by the reception of an e-mail and cites, "At the step S46", a "mail address, to which an error mail returns", is "registered in the external memory 4"; **page 15** (*of the English translation*), **paragraph 30, lines 9 – 11];**

a panel section configured to select the mail address of at least one user

stored in the memory

[As noted in the double patenting rejection, when an e-mail is transmitted later, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*)**];**

a controller

[Fig. 1, CPU **1** "is a CPU which controls the facsimile type e-mail apparatus"; **page 11** (*of the English translation*), **paragraph 20, line 5** (*from the top of the page*)**]**

configured to set the mail address of the user selected by the panel section into the mail from command of the e-mail to which the image data is attached, *whereby, when an error occurs*, a mail error message is returned to the mail address of the user

[TOYODA teaches that "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12]**.

the mail error message indicating an error in *one of* transmission of the e-mail by the image data communication apparatus and reception of the e-mail by the receiving apparatus

[Furthermore, TOYODA teaches that when transmitting image data by e-mail and an "error occurs to the e-mail", a "user can receive an error mail" at "a user's place" instead of at "the transmitting apparatus"; **page 10** (*of the English translation*)**, paragraph 19, lines 7 - 9].**

Regarding claim 21, TOYODA further teaches the image data communication apparatus according to claim 20, wherein

the image data attached to the e-mail is converted into a format for e-mail transmission

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network; **page 7** (*of the English translation*)**, lines 1 – 2].**

As for claim 22, TOYODA teaches a method for controlling an image data communication apparatus

[The description of **Fig. 1** cites a "facsimile type e-mail apparatus which is applied to the present invention"; **page 18** (*of the English translation*)**, paragraph "Fig. 1", lines 1 – 2]**

connected to an image data source

[Per claim 8, the "facsimile type e-mail apparatus" comprises a "scanner"; **page 3** (*of the English translation*), **lines 1 – 2]**

and to a network

[TOYODA teaches that the "facsimile type e-mail apparatus" is "connected with the network via the LAN"; **page 12** (*of the English translation*), **paragraph 24, lines 1 – 3]**,

and transmitting image data attached to an e-mail to a receiving apparatus via the network

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network. A transmitting terminal apparatus describes, in an e-mail, a control command including a predetermined unique character code, and transmits the e-mail. The *receiving apparatus* extracts the control command from the received e-mail at a receiving apparatus, analyzes the control command, and executes a predetermined control, based on the control command"; **page 7** (*of the English translation*), **lines 1 – 7]**,

the e-mail including a mail from command and a mail message,

[TOYODA teaches that when image data is transmitted by e-mail, "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12.** The sender's address "set in the e-mail" corresponds to the "mail from" command**]**

a memory storing a mail address of at least one user

[TOYODA teaches an alternate method of registering mail addresses by the reception of an e-mail and cites, "At the step S46", a "mail address, to which an error mail returns", is "registered in the external memory 4"; **page 15** (*of the English translation*), **paragraph 30, lines 9 – 11]**,

the method comprising:

selecting the mail address of at least one user stored in the memory

[As noted in the double patenting rejection, when an e-mail is transmitted later, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*)**];**

setting the selected mail address of the user into the mail from command of the e-mail to which the image data is attached, *whereby, when an error occurs,* the mail address of the user set into the mail from command of the e-mail is utilized as a destination of a mail error message

[TOYODA teaches that "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*)**, paragraph 33, lines 10 – 12].**

Regarding claim 23, TOYODA further teaches the method according to claim 22, wherein

the image data attached to the e-mail is converted into a format for e-mail transmission

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network; **page 7** (*of the English translation*)**, lines 1 – 2].**

As for claim 24, TOYODA teaches a method for controlling an image data communication apparatus

[The description of **Fig. 1** cites a "facsimile type e-mail apparatus which is applied to the present invention"; **page 18** (*of the English translation*)**, paragraph "Fig. 1", lines 1 – 2]**

connected to an image data source

[Per claim 8, the "facsimile type e-mail apparatus" comprises a "scanner"; **page 3** (*of the English translation*), **lines 1 – 2]**

and to a network

[TOYODA teaches that the "facsimile type e-mail apparatus" is "connected with the network via the LAN"; **page 12** (*of the English translation*), **paragraph 24, lines 1 – 3]**,

and transmitting image data attached to an e-mail to a receiving apparatus via the network

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network. A transmitting terminal apparatus describes, in an e-mail, a control command including a predetermined unique character code, and transmits the e-mail. The *receiving apparatus* extracts the control command from the received e-mail at a receiving apparatus, analyzes the control command, and executes a predetermined control, based on the control command"; **page 7** (*of the English translation*), **lines 1 – 7]**,

the e-mail including a mail from command and a mail message,

[TOYODA teaches that when image data is transmitted by e-mail, "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12.** The sender's address "set in the e-mail" corresponds to the "mail from" command]

a memory storing a mail address of at least one user

[TOYODA teaches an alternate method of registering mail addresses by the reception of an e-mail and cites, "At the step S46", a "mail address, to which an error mail returns", is "registered in the external memory 4"; **page 15** (*of the English translation*), **paragraph 30, lines 9 – 11**],

the method comprising:

selecting the mail address of at least one user stored in the memory

[As noted in the double patenting rejection, when an e-mail is transmitted later, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*)];

setting the selected mail address of the user into the mail from command of the e-mail to which the image data is attached, *whereby, when an error occurs,* a mail error message is returned to the mail address of the user

[TOYODA teaches that "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12].**

Regarding claim 25, TOYODA further teaches the method according to claim 24, wherein

the image data attached to the e-mail is converted into a format for e-mail transmission

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network; **page 7** (*of the English translation*), **lines 1 – 2].**

As for claim 26, TOYODA teaches a method for controlling an image data communication apparatus

[The description of **Fig. 1** cites a "facsimile type e-mail apparatus which is applied to the present invention"; **page 18** (*of the English translation*), **paragraph "Fig. 1", lines 1 – 2]**

connected to an image data source

[Per claim 8, the "facsimile type e-mail apparatus" comprises a "scanner"; **page 3** (*of the English translation*), **lines 1 – 2]**

and to a network

[TOYODA teaches that the "facsimile type e-mail apparatus" is "connected with the network via the LAN"; **page 12** (*of the English translation*), **paragraph 24, lines 1 – 3]**

and transmitting image data attached to an e-mail to a receiving apparatus via the network

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network. A transmitting terminal apparatus describes, in an e-mail, a control command including a predetermined unique character code, and transmits the e-mail. The *receiving apparatus* extracts the control command from the received e-mail at a receiving apparatus, analyzes the control command, and executes a predetermined control, based on the control command"; **page 7** (*of the English translation*), **lines 1 – 7]**,

the e-mail including a mail from command and a mail message

[TOYODA teaches that when image data is transmitted by e-mail, "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12.** The sender's address "set in the e-mail" corresponds to the "mail from" command],

a memory storing a mail address of at least one user

[TOYODA teaches an alternate method of registering mail addresses by the reception of an e-mail and cites, "At the step S46", a "mail address, to which an error mail returns", is "registered in the external memory 4"; **page 15** (*of the English translation*), **paragraph 30, lines 9 – 11]**,

the method comprising:

selecting the mail address of at least one user in the memory

[As noted in the double patenting rejection, when an e-mail is transmitted later, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*)**];**

setting the selected mail address of the user into the mail from command of the e-mail to which the image data is attached, *whereby, when an error occurs*, a mail error message is returned to the mail address of the user

[TOYODA teaches that "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12],**

the mail error message indicating an error in *one of* transmission of the e-mail by the image data communication apparatus and reception of the e-mail by the receiving apparatus

[Furthermore, TOYODA teaches that when transmitting image data by e-mail and an "error occurs to the e-mail", a "user can receive an error mail" at "a user's place" instead of at "the transmitting apparatus"; **page 10** (*of the English translation*), **paragraph 19, lines 7 - 9].**

Regarding claim 27, TOYODA further teaches the method according to claim 26, wherein

the image data attached to the e-mail is converted into a format for e-mail transmission

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-*

mail transmission, and to transmit the e-mail on a network; **page 7** (*of the English translation*), **lines 1 – 2].**

As for claim 28, TOYODA teaches a method for controlling an image data communication apparatus

[The description of **Fig. 1** cites a "facsimile type e-mail apparatus which is applied to the present invention"; **page 18** (*of the English translation*), **paragraph "Fig. 1", lines 1 – 2]**

connected to a network

[TOYODA teaches that the "facsimile type e-mail apparatus" is "connected with the network via the LAN"; **page 12** (*of the English translation*), **paragraph 24, lines 1 – 3]**,

and transmitting image data attached to an e-mail

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network. A transmitting terminal apparatus describes, in an e-mail, a control command including a predetermined unique character code, and transmits the e-mail. The *receiving apparatus* extracts the control command from the received e-mail at a receiving apparatus, analyzes the control command, and executes a predetermined

control, based on the control command"; **page 7** (*of the English translation*), **lines 1 – 7]**,

the e-mail including a mail from command and a mail message

[TOYODA teaches that when image data is transmitted by e-mail, "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12.** The sender's address "set in the e-mail" corresponds to the "mail from" command**]**,

a memory storing a mail address of at least one user

[TOYODA teaches an alternate method of registering mail addresses by the reception of an e-mail and cites, "At the step S46", a "mail address, to which an error mail returns", is "registered in the external memory 4"; **page 15** (*of the English translation*), **paragraph 30, lines 9 – 11]**,

the method comprising:

selecting the mail address of at least one user stored in the memory

[As noted in the double patenting rejection, when an e-mail is transmitted later, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user

designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*)**];**

setting the selected mail address of the user into the mail from command of the e-mail to which the image data is attached, ~~whereby a mail error message is returned to the mail address of the user,~~ *whereby, when an error occurs,* the mail address of the user set into the mail from command of the e-mail is utilized as a destination of a mail error message

[TOYODA teaches that "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12];**

and transmitting the image data attached to the e-mail to a receiving apparatus via the network

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network. A transmitting terminal apparatus describes, in an e-mail, a control command including a predetermined unique character code, and transmits the e-mail. The *receiving apparatus* extracts the control command from the received e-mail at a receiving apparatus, analyzes the control command, and executes a predetermined

control, based on the control command"; **page 7** (*of the English translation*), **lines 1 – 7].**

Regarding claim 29, TOYODA further teaches the method according to claim 28, wherein

the image data attached to the e-mail is converted into a format for e-mail transmission

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network; **page 7** (*of the English translation*), **lines 1 – 2].**

As for claim 30, TOYODA teaches a method for controlling an image data communication apparatus

[The description of **Fig. 1** cites a "facsimile type e-mail apparatus which is applied to the present invention"; **page 18** (*of the English translation*), **paragraph "Fig. 1", lines 1 – 2]**

connected to a network

[TOYODA teaches that the "facsimile type e-mail apparatus" is "connected with the network via the LAN"; **page 12** (*of the English translation*), **paragraph 24, lines 1 – 3]**,

and transmitting image data attached to an e-mail

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network. A transmitting terminal apparatus describes, in an e-mail, a control command including a predetermined unique character code, and transmits the e-mail. The *receiving apparatus* extracts the control command from the received e-mail at a receiving apparatus, analyzes the control command, and executes a predetermined control, based on the control command"; **page 7** (*of the English translation*), **lines 1 – 7**],

the email including a mail from command and a mail message

[TOYODA teaches that when image data is transmitted by e-mail, "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12.** The sender's address "set in the e-mail" corresponds to the "mail from" command],

a memory storing a mail address of at least one user

[TOYODA teaches an alternate method of registering mail addresses by the reception of an e-mail and cites, "At the step S46", a "mail address, to which an

error mail returns", is "registered in the external memory 4"; **page 15** (*of the English translation*), **paragraph 30, lines 9 – 11]**,

the method comprising:

selecting the mail address of at least one user stored in the memory

[As noted in the double patenting rejection, when an e-mail is transmitted later, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*)**];**

setting the selected mail address of the user into the mail from command of the e-mail to which the image data is attached, *whereby, when an error occurs*, a mail error message is returned to the mail address of the user, ~~whereby a mail error message is returned to the mail address of the user~~

[TOYODA teaches that "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12];**

and transmitting the image data attached to the e-mail to a receiving apparatus via the network

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network. A transmitting terminal apparatus describes, in an e-mail, a control command including a predetermined unique character code, and transmits the e-mail. The *receiving apparatus* extracts the control command from the received e-mail at a receiving apparatus, analyzes the control command, and executes a predetermined control, based on the control command"; **page 7** (*of the English translation*), **lines 1 – 7].**

Regarding claim 31, TOYODA further teaches the method according to claim 30, wherein

the image data attached to the e-mail is converted into a format for e-mail transmission

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network; **page 7** (*of the English translation*), **lines 1 – 2].**

As for claim 32, TOYODA teaches a method for controlling an image data communication apparatus

[The description of **Fig. 1** cites a "facsimile type e-mail apparatus which is applied to the present invention"; **page 18** (*of the English translation*), **paragraph "Fig. 1", lines 1 – 2]**

connected to a network

[TOYODA teaches that the "facsimile type e-mail apparatus" is "connected with the network via the LAN"; **page 12** (*of the English translation*), **paragraph 24, lines 1 – 3]**,

and transmitting image data attached to an e-mail

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network. A transmitting terminal apparatus describes, in an e-mail, a control command including a predetermined unique character code, and transmits the e-mail. The *receiving apparatus* extracts the control command from the received e-mail at a receiving apparatus, analyzes the control command, and executes a predetermined control, based on the control command"; **page 7** (*of the English translation*), **lines 1 – 7]**,

the email including a mail from command and a mail message

[TOYODA teaches that when image data is transmitted by e-mail, "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12.** The sender's address "set in the e-mail" corresponds to the "mail from" command],

a memory storing a mail address of at least one user

[TOYODA teaches an alternate method of registering mail addresses by the reception of an e-mail and cites, "At the step S46", a "mail address, to which an error mail returns", is "registered in the external memory 4"; **page 15** (*of the English translation*), **paragraph 30, lines 9 – 11]**,

the method comprising:

selecting the mail address of at least one user stored in the memory

[As noted in the double patenting rejection, when an e-mail is transmitted later, "a way for inputting the address of the sender" is through the panel where "a pre-registered table for addresses of senders is displayed, and then the user designates one address of a sender from the pre-registered table"; **page 17** (*of the English translation*), **paragraph 33, lines 1 – 5** (*from the top of the page*)**];**

setting the selected mail address of the user into the mail from command of the e-mail to which the image data is attached, *whereby, when an error occurs*, a mail error message is returned to the mail address of the user

[TOYODA teaches that "the address of the sender, set in the e-mail for transmitting image data, is an address to which an error mail returns"; **page 16** (*of the English translation*), **paragraph 33, lines 10 – 12],**

the mail error message indicating an error in *one of* transmission of the e-mail by the image data communication apparatus and reception of the e-mail by the receiving apparatus

[Furthermore, TOYODA teaches that when transmitting image data by e-mail and an "error occurs to the e-mail", a "user can receive an error mail" at "a user's place" instead of at "the transmitting apparatus"; **page 10** (*of the English translation*), **paragraph 19, lines 7 - 9];**

and transmitting the image data attached to the e-mail to a receiving apparatus via the network

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network. A transmitting terminal apparatus describes, in an e-mail, a control command including a predetermined unique character code, and transmits the e-mail. The *receiving*

apparatus extracts the control command from the received e-mail at a receiving apparatus, analyzes the control command, and executes a predetermined control, based on the control command"; **page 7** (*of the English translation*), **lines 1 – 7].**

Regarding claim 33, TOYODA further teaches the method according to claim 32, wherein

the image data attached to the e-mail is converted into a format for e-mail transmission

[TOYODA teaches that the "facsimile type e-mail apparatus" has "functions to *transform image data*, which is obtained from a document, *into a format for an e-mail transmission*, and to transmit the e-mail on a network; **page 7** (*of the English translation*), **lines 1 – 2].**

Claim Rejections - 35 USC § 103

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

29. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

30. Claims 4, 9, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over **TOYODA [Japanese Patent JP4 10307769A, published November 17, 1998]** in view of **ITO [Japanese Patent JP4 10191010 A, published July 21, 1998]**.

Regarding claims 4, 9, and 14, TOYODA *does not specifically teach* the image data communication apparatus according to claims 3, 8 and 13, respectively, wherein

the personal computer displays an HTML document for storing the mail address of the user in the memory.

ITO teaches a "facsimile apparatus which can connect to a local area network (LAN)"; **page 1** (*of the English translation provided by applicant*), **paragraph 1, lines 1 – 2**.

ITO's facsimile apparatus contains an "embedded web server". ITO cites, "A home page manager 14 stores a home page file of the facsimile apparatus described in HTML, and outputs the home page file in a response to a request of the HTTPD controller 13. Thus, when a WWW browser requests the facsimile apparatus to transmit the home page, the HTTPD controller 13 obtains the home page file from the home

page manager 14 and transmits it to the WWW browser"; **page 1** (*of the English translation*), **paragraph 24, lines 1 – 6.**

In addition, "a telephone list manager 15 stores telephone list information. The telephone list information consists of a pair of a sender name, which is registered by the user and which is often used, and" a "facsimile number. The telephone list manager 15 transforms the telephone list information into the HTML format and outputs it" in "response to a request from the HTTPD controller 13. Thus, when the WWW browser requests the facsimile apparatus to transmit the telephone list, the HTTPD controller 13 obtains, from the telephone list manager 15, a telephone list file described in HTML, and transmits it to the WWW browser"; **pages 1 - 2** (*of the English translation*), **paragraph 25.**

Furthermore, ITO teaches that "the telephone list information is merely referred" to "on the WWW browser, *but can technically be registered, corrected, and deleted on the WWW browser*"; **page 2** (*of the English translation*), **paragraph 42, lines 1 – 4.**

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of ITO with those of TOYODA so that, in a similar manner, e-mail addresses could be registered, corrected or deleted by means of a web browser displaying HTML which is sent to a personal computer over a network from the "image data communication apparatus".

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- **SHINOMIYA [Japanese Patent JP4 10341306A, published December 22, 1998]** teaches placing the e-mail address of a "transmitting user" in a "From" field of an e-mail header; **paragraph 37** (*of the English translation provided by applicant*);

- **POSTEL [RFC 821, "Simple Mail Transfer Protocol", August 1982]** teaches that "the argument of the MAIL command is a reverse-path, which specifies who the mail is from." In addition, "the reverse-path is a return route (which may be used to return a message to the sender when an error occurs with a relayed message)"; **page 3, paragraph 3** (*copy provided by applicant*);

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter L. Cheng whose telephone number is 571-270-3007. The examiner can normally be reached on MONDAY - FRIDAY, 8:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Y. Poon can be reached on 571-272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

plc
March 1, 2008

KING Y. POON
SUPERVISORY PATENT EXAMINER